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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,116	02/08/2001	Michael J. Broadhurst	20611	7682

151 7590 01/16/2004  
HOFFMANN-LA ROCHE INC.  
PATENT LAW DEPARTMENT  
340 KINGSLAND STREET  
NUTLEY, NJ 07110

EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/779,116	BROADHURST ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Laura L. Stockton, Ph.D.	1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 5-63, 65-67, 69-72 and 74 is/are pending in the application.
- 4a) Of the above claim(s) 65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-63, 66, 67, 69-72 and 74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

Claims 1, 5-63, 65-67, 69-72 and 74 are pending in the application.

### *Election/Restrictions*

The subject matter of claim 65 is directed to an invention which is patentably distinct from the elected invention. Note the formula in instant claim 1, the formula in instant claim 65 and the Restriction in Paper No. 5 dated January 29, 2002. The inventions are distinct, each from the other because of the following reasons: the elected invention and the invention of claim 65 differ materially in structure and element so much so as to be patentably distinct. In addition, a reference which anticipates one group may not even render obvious the other.

Claim 65 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

It is suggested that in order to advance prosecution, the non-elected subject matter be canceled when responding to this Office Action.

The indicated allowability of claim 1 is withdrawn in view of the newly discovered reference(s) to Gu et al. {U.S. Pat. 6,624,184}.

Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 7-63 and 74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 5, 19, 20, 23, 24, 27-29, 31, 34-36, 39, 40, 47, 51, 52, 54, 58, 59, 61, 63 and 74, the structures and /or wording are illegible.

In claims 7-19, 21-23, 25-27, 29-34, 36, 37, 39, 41-47, 49-51, 53, 54, 56-58, 60-62 and 74, there appear two (2) periods after the number of the claim and therefore, the second period should be deleted.

In claims 13 and 17, it appears that something is missing since there are two (2) commas following “aryl”.

Claims 23, 27, 31, 34, 39, 43, 44, 47, 48, 51, 54, 58, 61 and 63 do not conform to M.P.E.P. 608.01(m) since each claim must end with a period.

In claim 52, under the definition of  $R^{21}$ , an “or” should be added before “phenyl sulfonyl”.

In claim 55, under the definition of  $R^{27}$ , an “or” should be added before “heterocyclyl oxy”.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5-8, 10-14, 16-19, 62, 66, 67 and 69-72 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gu et al. {U.S. Pat. 6,624,184}.

Gu et al. disclose and claim specie which are embraced by the instant claimed invention. See, for example, the compounds of Table I starting at columns 35-36 (compounds 1, 13, etc.) and claim 12 of the patent.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-23, 28-34, 52-63, 66, 67, 69-72 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gu et al. {U.S. Pat. 6,624,184}.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Applicants claim oxazole compounds. Gu et al. (columns 8-12, 15, 27-29; and especially the compounds in Table I starting at columns 35-36) teach oxazole compounds which are either structurally the same as (see above 102 rejection) or structurally similar to the instant claimed compounds.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between some of the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*

The indiscriminate selection of “some” among “many” is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., IMPDH inhibitor).

One skilled in the art would thus be motivated to prepare compounds embraced by the prior art to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds that would inhibit IMPDH and which would be useful in treating diseases/disorders such as inflammatory disorders. The instant

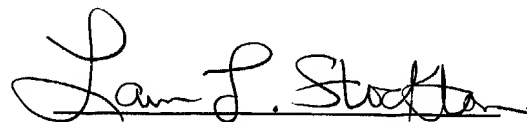


claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

January 15, 2004